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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,643	07/20/2001	Andrew S. Kanter	0010-3	1842
25901	7590	11/18/2005		
ERNEST D. BUFF ERNEST D. BUFF AND ASSOCIATES, LLC. 231 SOMERVILLE ROAD BEDMINSTER, NJ 07921			EXAMINER CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/909,643

Applicant(s)

KANTER, ANDREW S.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 2/14/05.

#### ***Response to Amendment***

2. The amendment filed 2/14/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has added claim language that upon registration, the user surrenders any option to decline to receive said advertisements during said access to said ISP. This cannot be found in the disclosure. Applicant points to portions of the specification, yet these portions merely state that the user is unable to minimize, close or move the ad and that the ads open and close automatically. Support is had for limiting user control of ads, yet no mention is made of options to decline to receive ads, nor the ability to surrender any such option, much less such surrendering being done upon registration. Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant has added claim language that upon registration, the user surrenders any option to decline to receive said advertisements during said access to said

ISP. This cannot be found in the disclosure. Applicant points to portions of the specification, yet these portions merely state that the user is unable to minimize, close or move the ad and that the ads open and close automatically. Support is had for limits of the user control of ads, yet no mention is made of options to decline to receive ads, nor the ability to surrender any such option, much less such surrendering being done upon registration.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8, 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1d, there is no antecedent basis for "said database."
- Claims 1, 8, 15, 16, there is no antecedent basis for "any option."

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1, 3-8, 10-15, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Goldhaber et al (US5855008).**

Regarding claim 1, 8, 12, 15, Landsman et al teaches interstitial ads displayed to a user's browser from an Internet server. The ads are described as being displayed in browser popup windows which are shown to the user for a specified period of time (i.e. the duration of the ads) and the popup window is then removed upon completion. Landsman et al teaches that the AdDescriptor may specify that the user is NOT permitted to prematurely terminate (close) the ad displayed [32:5-46, fig 20]. The AdDescriptor file also specifies the duration of the ads [32:15-20, 37-40]. This is taken to provide a non-dismissible ad window that is temporarily shown for a pre-determined amount of time; the user cannot prevent ads from being shown and effectively surrenders any option to decline to see such ads. Further it would have been obvious for one of ordinary skill in the art at the time of the invention for the user to be made aware of the advertising procedures (user has no control) provided by the system and for the user to agree to surrender any option to prevent the ads. Landsman et al also teaches that a log is kept regarding each ad impression [31:53-58]. Landsman et al also teaches targeting ads based on stored user profiles [21:13-20] – this is taken to provide the registered user database and ad viewing history. When a user requests a subsequent webpage (via the user's ISP server(s)), the advertising display is triggered. Landsman et al does not teach compensation. Goldhaber et al teaches many embodiments whereby a registered computer user is compensated for viewing advertising [abstract]. The advertising can be targeted based on the registered

user's demographics. The compensation can be routed to the user's registered account. It would have been obvious to one of ordinary skill at the time of the invention to have registered and compensated the ad-viewing users of Landsman et al's system so that users may be motivated to and may benefit from viewing online ads.

Regarding claims 3, 6, 7, 11, 20, Landsman et al teaches that the AdDescriptor file can specify the size and location of the ad window [fig 20]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the window anywhere including the top of the user's screen as a design choice so that the ad is quite visible. Landsman et al teaches that ads are known to include hotlinks to the advertiser and advertiser web pages [3:40-46]. It would have been obvious to one of ordinary skill at the time of the invention to have provided URLs for the ad objects so that a user may click on ads they are interested in. Official Notice is taken that it is well known for an advertiser to collect email/postal mailing addresses (demographic info) of interested prospective customer so that they can deliver more information about their products, services, sales promotions, etc. It would have been obvious to one of ordinary skill at the time of the invention to have provided fillable forms/windows on the advertiser's site in order to collect such information when user's request more information be sent to them. Further, it would have been obvious to one of ordinary skill at the time of the invention to have provided registration buttons and fillable forms/windows on the web site in order to collect registration information pursuant to Goldhaber et al's compensation. Goldhaber et al further discusses collection of personal data at registration time.

Regarding claims 4, 10, Landsman et al's plurality of ads to be shown and the ad queue are taken to provide a "series of ads" shown in an ad window.

Regarding claims 5, 14, the ad display is programmed to be delayed until the user transitions to a subsequent page. Further, Landsman et al teaches ads that sleep for a predetermined time period before they are shown again [32:25-33].

Regarding claim 13, when a user leaves a previous web site and triggers the ads, this action is taken as closing a computer program, the program being the HTML-programmed web site content.

**7. Claims 2, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Goldhaber et al (US5855008) and Radziewicz et al (US5854897).**

Regarding claims 2, 16, 17, Radziewicz et al also teaches interstitial ads. Radziewicz et al teaches that the user's connection speed to the Internet can be measured and the speed results can be used to select a particular format for the ads [11:7-28]. It would have been obvious to one of ordinary skill at the time of the invention to have specified various ad formats in the AdDescriptor file so that the user can receive rich multimedia ads if their PC/connection could handle such files.

Regarding claims 18, 19, Official Notice is taken that using a wireless connection in order to access the Internet is well known. It would have been obvious to one of ordinary skill at the time of the invention for wireless users to have participated in the combined system so that they can enjoy the Internet wirelessly.

***Response to Arguments***

8. Applicant argues that the ads are shown for a predetermined time and that the user cannot elect to decline to see the ads. Examiner points again to column 32 lines 17-22 which states that the system displays an ad, waits a configurable amount of time (pre-specified in the AdDescriptor file) and terminates that ad visually upon completion. The option for a user to prematurely close the ad can be disabled by a setting in the AdDescriptor file, therefore resulting in an ad window that is non dismissible and temporarily visible for a predetermined amount of time. Column 32 lines 33-40 further describe programming that provides a popup ad which is displayed "for a pre-defined period of time" and "removes the pop up window." A user cannot prevent the ads from being shown.

9. Applicant argues that Goldhaber et al differs from the instant invention because the users of Goldhaber et al may elect to view the ads. Examiner is not using Goldhaber et al as a base reference, but rather Landsman et al which may be programmed to eliminate user control of the ads. Goldhaber et al is provided as a secondary teaching for compensation earned for viewing ads.

10. Applicant argues that extensive reconstruction would be required to provide the combination proposed. Examiner agrees that some reconstruction would be required but




that it would be within the knowledge of one having ordinary skill in the art. Motivation for the combination is believed to be proper.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc